

REMARKS

Applicants thank the Office for the indication that Claims 1, 5-14, and 17-24 have been allowed.

Claims 16, 25, and 26 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In view of the amendments and the following remarks, Applicants respectfully request reconsideration and allowance of Claims 16, 25, and 26.

The Office asserts that although Claims 16, 25, and 26 “are directed toward a computer storage medium storing instructions to perform the method of Claim 1, and a graphical user interface, and, a computer storage medium storing application code respectively, the specification only discloses software embodiments of the invention, which amounts to a computer program.” Office Action, p. 3. The Office then asserts “[a] computer program does not fall within one of the statutory classes of invention under 35 U.S.C. § 101, therefore, claims 16, 25, and 26 are directed toward a non-statutory subject matter.” Office Action, p. 3.

Applicants respectfully assert that it seems the Office has incorrectly applied 35 U.S.C. § 101 to Applicants’ Claims. Specifically, Claim 16 is patentable by calling for a computer readable storage medium having stored thereon program instructions for executing the process claimed therein. Under MPEP § 2106.01(I):

[C]omputer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions. Emphasis added.

As can be seen, MPEP § 2106.01(I) makes clear that a computer-readable medium encoded with a computer program is statutory subject matter. Nothing in the cases cited by the Office, including *In re Bilski*, change the fact that a computer-readable medium encoded with a computer program is statutory subject matter. See also, the post-*Bilski* matter *Ex parte Bo Li*, App. 2008-1213 (BPAI Nov. 6, 2008), which specifically approves of such Beauregard claims.

Additionally, MPEP § 1412.02(III) recites:

A patentee may file a reissue application to permit consideration of article of manufacture claims (not presented in the patent to be reissued) which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. *Emphasis added.*

While MPEP § 1412.02(III) relates to broadening reissue applications, it further illustrates the point that computer-readable storage medium, and particularly computer-readable storage medium claims corresponding to process claims which have been patented, are statutory under 35 U.S.C. § 101. Thus, Applicants respectfully assert where a process is allowable, the claim for the process stored on a computer-readable storage medium is also allowable.

Furthermore, in response to the Office's assertion that "the specification only discloses software embodiments of the invention . . .," Applicants respectfully point the Office to Applicants' specification, wherein Applicants recite:

In the described embodiment, . . . the voice application development process is implemented by software modules stored on hard disk storage of the voice application development system 100. However, it will be apparent to those skilled in the art that at least parts of the voice application development process can be alternatively implemented by dedicated hardware components such as application-specific integrated circuits (ASICs). Para. [0042] (*emphasis added*).

Thus, in stark contrast to the Office's assertion, Applicants clearly disclose more than mere software embodiments of the claimed invention. Particularly, in one embodiment, Applicants disclose software modules stored on a computer-readable storage medium. In view of the foregoing, Claim 16 comprises statutory subject matter.

Claim 25 is patentable for similar reasons as Claim 16 by calling for a “graphical user interface for use in developing a voice application, said interface including graphical user interface components associated with executable program code stored on a computer-readable storage medium and processed by a computer system . . .” (emphasis added). Therefore, under MPEP § 2106.01(I), Claim 25 comprises statutory subject matter.

Claim 26 is patentable for similar reasons as Claim 16 by calling for a “computer readable storage medium having stored thereon application code for a voice application . . .” Therefore, under MPEP § 2106.01(I), Claim 26 comprises statutory subject matter.

In view of the foregoing, it is respectfully submitted that the claims of record are allowable and that the application should be passed to issue. Should the Examiner believe that the application is not in condition for allowance and that a telephone interview would help further prosecution of this case, the Examiner is requested to contact Nathan Witzany at the phone number below.

Respectfully submitted,

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